REMARKS:

Applicant appreciates the time and care the examiner has taken in examining the application.

Comments on Amendments to the Specification. Applicant presents again for entry the amendments previously presented on December 19, 2005. The substitute specification is resubmitted with paragraph numbers as suggested in 37 CFR §1.52(b)(2) and corresponding to the numbers assigned in the publication of this application, Pub. No. 2004/0221723 A1. It is respectfully noted that the new matter statement was included in the first Response to Office Action, at page 11 lines 5-6. Applicant states again under 37 CFR §1.125(b) that the enclosed substitute specification includes no new matter.

Comments on Amendments to the Claims. In the amendment above, claims 19-21, 23-25, 27-28, 31-39, and 41-47 have been cancelled. The pending claims are 14-18, 22, 26, 30, and 40.

Response to Claim Rejections.

1. Rejection of Claims 14, 15, 18, 19, 22, 23, 35, 36, 39, 44 and 45 under Section 103(a) as unpatentable over Tanaka, U.S. Patent No. 6,431,318, in view of Majewski, U.S. Patent No. 4,401,189.

Of the claims rejected, Claims 14, 15, 18, and 22 remain pending, and the rejection is respectfully traversed as to these claims. Critical features of amended base claim 14 are: (a) an endless circulating carrying path, and (b) a container throwing-in prohibited area provided in an

upstream side of the circulating carrying path from a position of the identification information reading means. In dependent claim 15, the throwing-in prohibited area comprises a throwing-in protecting wall.

The throwing-in prohibited area is provided for avoiding a problem associated with prior art identification information reading devices, wherein such reading devices failed to precisely read the identification, because when a person tried to add a food/drink container to a circulation carrying path near the identification information reading device, if food/drink containers already were in the throwing-in area, the added food/drink container would push through those food/drink containers, and the food/drink containers that were in the downstream side from the throwing-in area would be temporarily running or overlapping with one another. (Substitute Specification at [0015] (the enclosed clean version of the Substitute Specification is cited in this Response, and is hereinafter referred to as "Sub. Spec.")). Accordingly, the throwing-in prohibited area advantageously allows that, at the time of the throwing-in of a container, the containers that are in the downstream side from the throwing-in area are not temporarily running or overlapping with one another in the place of the identification information reading means, and so, the reading of the identification information will can be accurately performed. (Sub. Spec. at [0054]).

Tanaka discloses a conveying path 3, which the Examiner considers as reading on the circulation-type carrying path of claim 14 herein. However, Tanaka fails to disclose a container throwing-in prohibited area, as pointed out by the Examiner. Majewski teaches a separating member 23 located adjacent to two rear transport belts 17 and 18. The Examiner considers that the area in close proximity to the separating member 23 reads on the container throwing-in prohibited area of Claim 14 of the present invention, and furthermore, that the separating member 23 reads on the throwing-in protecting wall of Claim 15 of the present invention.

However, the article conveying apparatus of Majewski is a branched-type transport belt, as shown in Figs. 1 and 4 of Majewski, and is not of the endless-circulating type as in Claim 14.

The separating member 23 of Majewski is positioned between two rear transport belts 17 and 18, and their respective separate loading platforms 19, and 20 at their ends. (Majewski col. 2 lines 63-65). The separating member 23 clearly is positioned and employed for the purpose of keeping the previously-sorted grocery items from falling off of one of the two rear transport belts 17 or 18 onto the other rear transport belt 17 or 18, or from falling from one loading platform 19 or 20 onto the other loading platform 19 or 20. (*See* Majewski Fig. 1). The separating member 23 of Fig. 1 in Majewski has nothing to do with preventing throwing-in, because all of the throwing-in was previously accomplished upstream, at the place of the common ramp 16, by the cashier at position 14 with the aid of the diverter bar 25. (Majewski col. 2 lines 54-57 and 63-65, and col. 3 lines 53-66). Thus, in view of the different purpose and different position of the separating member 23 as compared to the throwing-in prohibited area of Claim 14, it is submitted that the separating member 23 does not read on the throwing-in prohibited area of Claim 14, and that therefore the combination of Majewski with Tanaka fails to render obvious the claimed invention.

Moreover, as shown in Fig. 1 of Majewski, the separating member 23 is located in the downstream side of sensors S1 and R1. Although in Fig. 4 of Majewski, the rear transport belts 17 and 18 are provided with sensors S2 and R2, and S3 and R3, respectively, the separating member 23 is not provided in Fig. 4, and sensors S2 and R2 and S3 and R3 are photoelectric sensors having the function of providing a signal for stopping the motion of the two rear transport belts 17 and 18 when any item is detected. (*See* Majewski Fig. 4 and col. 5 lines 17-35). Even if, by mistake, an item were thrown over the separating member 23 onto the wrong transport belt 17 or 18, the reading taken by the sensors S2, S3 and R2, R3 would not be in the manner of incorrect data about the identity of the item; recall that Claim 14 herein provides specifically for "an identification information reading means for reading identification information on containers, adapted to identify individual containers." Thus, the structure and function of the separating member and sensors of Majewski render them distinct from the

throwing-in prohibited area provided in an upstream side of the circulating carrying path from a position of the identification information reading means, as set forth in Claim 14, such that the combination of Majewski with Tanaka fails to render obvious the claimed invention.

Accordingly, the configuration corresponding to the express limitations of Claim 14 is neither disclosed in, nor suggested or motivated by, the combined features of Tanaka and Majewski. "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). "The level of skill in the art is a prism or lens through which a judge or jury views the prior art and the claimed invention. This reference point prevents these deciders from using their own insight or, worse yet, hindsight, to gauge obviousness." *Al-Site Corp. v. VSI International, Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d 1161, 1170 (Fed. Cir. 1999). As stated in *McGinley v. Franklin Sports Inc.*, 262 F.3d 1339, 60 U.S.P.Q.2d 1001, 1008 (Fed. Cir. 2001):

> "The genius of invention is often a combination of known elements which in hindsight seems preordained. To prevent hindsight invalidation of patent claims, the law requires some 'teaching, suggestion or reason' to combine cited references. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 U.S.P.Q.2d 1378, 1383 (Fed. Cir. 1997). When the art in question is relatively simple, as is the case there, the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously."

These standards clearly have not been met. It is apparent that no prima facie case of obviousness has been established. The rejection should be reconsidered and withdrawn.

2. Rejection of Claims 16, 17, 21, 22, 24, 25, 37, 38, 46 and 47 as unpatentable over Tanaka, U.S. Patent No. 6,431,318, in view of Majewski, U.S. Patent No. 4,401,189, as applied to Claim 14 above, and further in view of Watanabe et al., U.S. Patent No. 5,557,096.

Of the claims rejected, Claims 16, 17, and 22 remain pending, and the rejection is respectfully traversed as to these claims. Claim 16 states that the container throwing-in prohibited area comprises a tunnel-shaped cover that covers the containers, and Claim 17 further provides that the identification information reading means is positioned inside the tunnel-shaped cover, and that the device further comprises an electromagnet shield on the tunnel-shaped cover. Claim 22 provides that the sign part of Claim 14 has sign identification information readable by the identification information reading means, and that the identification information reading means is combined with the passage detection means.

Claim 16 depends from Claim 14, and so Claim 16 is patentable over the cited references for all the reasons advanced in the preceding section, herein incorporated by reference. The Examiner adds Watanabe to the combination of Tanaka and Majewski as applied to Claim 14 above, in order to yield the rejection of pending Claims 16, 17 and 22. Watanabe teaches a scanning arrangement (*See* Watanabe Fig. 56) that incorporates interrogator 335 that reads information from circuit 347 contained within slip paper 336 as the slip paper 336 passes through electromagnetic shields 344 and 345 (*See* Watanabe col. 36 lines 14-28). The Examiner considers that the interrogator 335, slip paper 336, and electromagnetic shields 344 and 345 read on the present invention's identification information reading means, carrying path, and tunnel-shaped-cover, respectively, and furthermore, that it would have been obvious to "...incorporate the tunnel-shaped electromechanical [sic] shields 344 and 345 of Watanabe into the scanners of Tanaka to provide an effective means of shielding said scanners from electromechanical interference and unwanted objects." (Office action p. 5). The electromagnetic shields 344 and 345 of Watanabe are provided for preventing the preceding and succeeding responding circuits 347 from receiving radio waves transmitted by the interrogator 335. (Watanabe col. 36 lines 14-19). The electromagnetic shields 344 and 345 of Watanabe are not provided for preventing the throwing-in of containers near the place of the identification information reading means, as in the present invention. (Sub. Spec. at [0056]). The slip paper 336 does not require such

configuration since no new slip paper would be thrown in to any conveying path. Further, the Watanabe configuration is in no way analogous to the features of claim 17, given that claim 17 specifies that the identification information reading means in positioned *inside* the tunnel-shaped cover, and that there is an electromagnet shield on the cover. Clearly, Watanabe's interrogator 335 is located outside the electromagnetic shields 344 and 345. (Watanabe Fig. 56). If Watanabe's interrogator 335 (held by the Examiner to read on the present invention's identification information reading means) were to be located inside of the electromagnetic shields 344 and 345, as the Examiner suggests, circuits other than the circuit 347 on the chosen paper slip 337 would also be read by the interrogator 335, and the electromagnetic shields 344 and 345 of Watanabe would not provide the desired function. The proposed combination of features from the three disparate references is non-operable, does not lead to the instant invention, and is not analogous of the instant invention. Nothing in the three disparate references cited suggests or motivates their combination to yield in the invention as claimed.

3. Rejection of Claims 26, 27 and 30-34 as unpatentable over Tanaka, U.S. Patent No. 6,431,318, in view of Majewski, U.S. Patent No. 4,401,189, as applied to Claim 14, and further in view of Tokimoto, U.S. Patent No. 6,554,106.

Of the claims rejected, Claims 26 and 30 remain pending, and the rejection is respectfully traversed as to these claims. Claims 26 and 30 depend from Claim 14, and so these claims are patentable over the cited references for all the reasons advanced in the first section of this argument, herein incorporated by reference.

4. Rejection of Claims 40 and 41 as unpatentable over Tanaka, U.S. Patent No. 6,431,318, in view of Majewski, U.S. Patent No. 4,401,189, as applied to Claim 14, and further in view of Tokuno, U.S. Patent No. 6,581,727.

Of the claims rejected, Claim 40 remains pending, and the rejection is respectfully traversed as to this claim. Claim 40 depends from Claim 14, and so is patentable over the cited

references for all the reasons advanced in the first section of this argument, herein incorporated by reference.

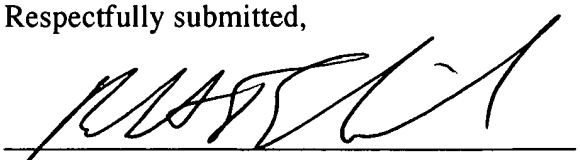
5. Rejection of Claims 42 and 43 as unpatentable over Tanaka, U.S. Patent No. 6,431,318, in view of Majewski, U.S. Patent No. 4,401,189, in view of Watanabe et al., U.S. Patent No. 5,557,096, as applied to Claim 16, and further in view of Tokuno, U.S. Patent No. 6,581,727.

These claims have been cancelled.

It is respectfully submitted that the application is in condition for prompt allowance and that all of the objections, rejections and requirements raised in the Office action have been met. Early, favorable treatment of this application is requested.

Extension Request and Deposit Account Fee Authorization. The Commissioner is hereby authorized to charge any fees associated with this communication, including any necessary fees under 37 CFR § 1.17(a) for any necessary extensions of time under 37 CFR §1.136(a), which are hereby requested, to our Deposit Account No. 50-0305. The Examiner is encouraged to call Robert J. Schneider at the direct number (312) 845-3919 with any questions that arise in connection with this application, or to resolve any remaining issues.

Respectfully submitted,



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CERTIFICATE OF MAILING UNDER 37 CFR § 1.8

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I hereby certify that the attached correspondence, namely: Response to Office Action, with clean and marked copies of substitute specification, and return postcard and this certificate of mailing, is being deposited on the date listed above under 37 C.F.R. §1.8 with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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